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10/582,714

06/12/2006

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EXAMINER

FAN, HONGMIN

ART UNIT

PAPER NUMBER

2612

MAIL DATE

DELIVERY MODE

01/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/582,714

Applicant(s)

ROBIN ET AL.

Examiner

Hongmin Fan

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 2 is objected to because of the following informalities: line 1, "Security document as claimed in claim 2" should be -- Security document as claimed in claim 1--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rancien et al (US Pub 2003/0168514) in view of Friedman (US 6127938).

As to claim 1, referring to Fig. 1-2, Rancien et al disclosed a document having a RFID (i.e. transponder) comprising a chip 31 (i.e. electronic module) and an antenna 32 to communicate to a reader (0058, line 5).

Rancien et al did not disclose a passive masking element. However, it is known in the art to provide a shielding (or masking) for a transponder in order to prevent unauthorized access. Referring to Fig. 6-7, Friedman teaches an adjustable shield 64 for a transponder 10. When shielding member 64 is in the position shown in FIG. 6, it will prevent communication between the transponder 10 and an externally located interrogator. Conversely, when the shielding member 62 is manually moved to the

position shown in FIG. 7, it will no longer block the transmission of the vehicle identification signal between transponder 10 and the external interrogator (col. 5, line 6-12).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to incorporate a mask in Rancien's document in order to provide protection against unauthorized access.

Claims 2-3, 6, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rancien et al in view of Friedman, further in view of Adams et al (US 7106196).

As to claim 2-3, Friedman did not teach that masking element comprises a thin metallic layer of a given form. However, it is known in the art that masking is made of thin metallic layer. Referring to Fig. 1-2, Adams et al teach a thin layer metallic layer of shielding (col. 2, line 16). Further, one of ordinary skills in the art clearly recognizes that as long as the mask matches the form of the antenna, it will shield the transmission. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to incorporate a thin metallic layer as the mask in Rancien's document in order to mask the transmission.

As to claim 6, Adams et al teach that an RF interfering or absorbing surface treatment for a RFID device may be ... printed inks using silk screen printing technology or other printing methods (col. 2, line 10-15).

As to claim 9, Adams et al teach as shown in FIG. 1, the pattern of deposition may be in a screen format (i.e. lossy), for example, pattern of dots 10 across surface 20 of the label. Alternatively, the pattern of deposition may be in a grid format.

As to claim 10, it is well known in the art that ferrite composite is used as shielding material.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rancien et al in view of Friedman, further in view of Adams et al, further in view of D'hont (US 5557279).

As to claim 4-5, Friedman or Adams et al did not teach that the thin layer is an aluminum sheet. However, it is known in the art to use aluminum sheet as mask. D'hont teaches a transponder shield comprising an aluminum metal sheet (Claim 2). Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to incorporate a thin aluminum sheet as the mask in Rancien's document since it is known in the art.

As to claim 7-8, one of ordinary skills in the art readily recognizes that one way to attach the thin layer, such as aluminum sheet, is to glue to other part of the document, i.e. other pages.

As to claim 11-14, referring to Fig. 1-2, Rancien et al disclosed a passport 10 with as a front cover 20, a back cover 22, a fold 21 (i.e. interlined elements) and sheets 11. One of ordinary skills in the readily recognizes that the back cover or sheets may be

used as shield such that when the passport is closed it will not be able to communicate with the reader.

Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rancien et al in view of Friedman, further in view of Adams et al, further in view of D'hont, further in view of Petsinger (US 6121544).

As to claim 15-16, Rancien et al or Friedman did not disclose a card and a protective case. However, it is known in the art to have a RFID card with a protective case. Referring to Fig. 1-2, Petsinger teaches electromagnetic shield to a contactless smartcards comprising a two shell 40 with shielding material 42 and a smartcard 46 (i.e. transponder). Fig 2 shows the fully assembled cardholder with the contactless smartcard 44 fully inserted into the magnetic shielding material 42 sandwiched between the two plastic reinforcing shells 40 (i.e. recess) (col. 8, line 20-23). Furthermore, one of ordinary skills in the art readily recognizes one way to make the case open is to use a hinge, like cigarette case for easy access. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention have a transponder card and a protective case with hinge for easy access and shielding.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hongmin Fan whose telephone number is 571-272-2784. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

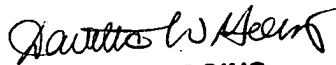
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Hofsass can be reached on 571-272-2981. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HF


DAVETTA W. GOINS
PRIMARY EXAMINER